

REMARKS/ARGUMENTS

The Examiner's attention to the present application is noted with appreciation.

In paragraphs 1 through 3, page 2 of the Office Action dated August 6, 2003, the Examiner objected to the amendments filed January 31, 2002 and October 22, 2002 under 35 U.S.C. §132 for introducing new matter into the disclosure. We appreciate that the Examiner reviewed the application in detail, and would like to apologize for any possible confusion due to previous amendments. Applicant respectfully requests that any matter that the Examiner considers new matter from the amendments filed January 31, 2002 and October 22, 2002 be canceled.

The Examiner's specific concerns, which have been addressed, are as follows: In paragraph 1 on page 3 of the Office Action, the Examiner objected to page 1, in the paragraph beginning at line 8 in line 12 after "microbial growth" the insertion of the phrase ---and act as a strong demulsifier...,---. This phrase has been deleted.

In paragraph 2 on page 3 of the Office Action, the Examiner objected to page 8, in the paragraph beginning on line 19, line 21 the change "0.03" to ---0.05---. Applicants have amended the specification to go back to the original language.

In paragraph 3 on page 3 of the Office Action, the Examiner objected to page 9, in the paragraph beginning on line 12, line 13 changes "0.3 parts" to ---0.03 parts---. (This amendment previously offered was incorrect as there is no such wording on page 9, line 13). In paragraph 4 on page 3 of the Office Action, the Examiner objected to the same page and paragraph to the insertion of ---0.005--- and the insertion of ---0.3---. Applicants have amended the specification to go back to the original language.

In paragraph 5 on page 3 of the Office Action, the Examiner objected to page 12, in the paragraph beginning on line 6, the deletion in lines 8 and 9. These deletions have been added back to the original specification in the amendment to the specification of this response.

In paragraph 6 on page 3 of the Office Action, the Examiner objected to page 13, at lines 15 and 20 the deletion of " '462 patent" and insertion of---prior art---; on page 14 at line 2 of paragraph 3 the deletion of " '462 composition' and insertion of ---prior art sample---; and at line 7 of paragraph 3 of page

14 the deletion of “ ‘462” and insertion of ---prior art---. These changes have been made to go back to the original specification in the amendment to the specification of this response.

In paragraphs 6 and 7 on page 3 of the Office Action, the Examiner rejected claim 103 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, stating that applicants did not point out to the Examiner the specific location of the language from the instant application in the specification and claims as originally filed. The Examiner objected to the “0.005 and approximately 0.150” limitation. We agree that the “0.005” limitation is incorrect. We note that claim 103 reads “0.05” and not “0.005” as the Examiner has suggested. The “0.05” limitation is supported by the original specification and claims, as discussed below. Claim 103 reads “The fuel additive of claim 102 wherein said metal deactivator comprises between approximately 0.05 and approximately 0.15 parts by weight.” This language, except the claim number on which it depends, is the language found in original claim 38. Further, the language “The metal deactivator more preferably comprises between approximately 0.05 and approximately 0.15 parts by weight,…” is also found on page 9, beginning at line 13 of the specification in the originally filed application.

In paragraphs 1 through 3, on page 4 of the Office Action, the Examiner rejected claim 90 under 35 U.S.C. §112, second paragraph, indicating that the limitation “viscosity is approximately 20 weight or less” is indefinite because it is unclear as to the unit of measurement that is being referenced. Applicant disagrees. Claim 90 teaches that the fuel additive is a lubricant with a viscosity of 20 weight or less. Viscosity is the property in oil which allows it to maintain shearing stress and resistance to flow. Low viscosity means that the oil is thin and flows easily. A higher number indicates thicker oil which is more resistant to flow. Viscosity is usually measured in centistokes which is then converted to weights by the Society of Automotive Engineers (SAE). Weights are developed from charts which designate arbitrary numbers to viscosity at different temperatures. The designation of a 20 weight lubricant refers to its viscosity at 0° F. We believe that claim 90 does therefore appropriately identify a standard unit of measurement known in the art.

In paragraphs 4 and 5, on page 4 of the Office Action, the Examiner rejected claims 162-170 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that the limitation “a non-platinum organo-metallic compound” is considered as new matter because it contradicted the originally filed claims and the bridging paragraph at pages 6-7 of the instant application. Original claim 1 (and currently amended claim 67) of the instant application teaches an “iron-containing organometallic compound.” Original claim 9 teaches that the organometallic portion of the compound may comprise manganese (Mn), platinum (Pt) or cerium (Ce). In addition, the bridging paragraph on pages 6-7 (in the instant application), sentences 1-2 read “The organometallic compound utilized is preferably iron. Manganese, platinum and cerium may also be utilized separately, mixed or mixed with iron.” Therefore, the use of platinum is an alternative, with corresponding “non-platinum” embodiments as other alternatives. The non-platinum organometallic compound of currently amended claim 162 is further limited by currently amended claim 164 which reads “said organometallic compound comprises at least one compound selected from the group consisting of Fe, Mn, Ce and mixtures...” These are clearly alternative embodiments. Again, applicant is claiming the non-platinum embodiments as described in the original specification. No new matter has been added. Applicant is allowed to put negative limitation wording in a claim to indicate there is no platinum in the organometallic compound, as supported by the specification in numerous such embodiments. Applicant would be willing to recite “an organo-metallic compound other than a platinum compound” if this would satisfy the Examiner’s concerns.

In paragraphs 6 and 7 of page 4, and bridging onto page 5 of the Office Action, claims 67-170 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner stated that the “iron-containing organo-metallic compound” of claim 67 and the “non-platinum metallic-metallic compound” of claim 162 is indefinite and confusing when viewed in light of the “comprising” language of line 1 requiring at least two components. In order to correct the Examiner’s typographical errors, we believe the Examiner meant “organo” rather than “oregano” in claim 67 and “organometallic” instead of “metallic-metallic” in claim 162. In any event, it is well known that the word “comprising” means “including”

or “having”, and does not require at least two components. This rejection is therefore completely inappropriate. We do not understand the Examiner’s rejections.

In the bridging portion of paragraph 17 from page 4 to page 5 of the Office Action, the Examiner rejected claims 67-170 under 35 U.S.C. §112, second paragraph, taking the position that the limitation “said fuel additive is to be added to the fuel...5,000 parts per volume of the fuel” is a future limitation directed to a fuel composition. Claims 67 through 170 have been amended to address the Examiner’s remarks. The claims are all now directed to a fuel composition comprising a fuel additive.

In the first full paragraph on page 5 of the Office Action, the Examiner rejected claims 67 and 170 (and their pending claims [we believe the Examiner meant “dependent” claims]), under 35 U.S.C. §112 stating that these claims are indefinite and confusing because it is unclear as to the units of measurement that is being used for the metallic-metallic compound being referenced. As stated above, applicant does not recite a “metallic-metallic” compound, so we believe the Examiner is referring to an “organo-metallic” compound. As to the units of measurement for the organometallic compound, applicant is using “parts by weight” and “parts by volume.” Claims 67 and 170 (and numerous other claims) are composition claims. Composition claims often recite weight percent, volume percent, parts by weight, parts per volume, atomic percent, etc. We do not understand the Examiner’s rejection and believe it is completely inappropriate.

In paragraph 2 on page 5 of the Office Action, the Examiner rejected claims 91, 92, 96, 97, and 103 under 35 U.S.C. §112, second paragraph, are indefinite and confusing because “it is unclear from the specification and originally filed claims as to the metes and bounds for the unit of measurement that are being used for the said additive components. As discussed above, It is well understood in the art that “parts by weight” and “parts by volume” are well understood forms of measurement. Claims 91 and 92 relate to the fuel additive “additionally comprising a lubricant” and that lubricant is measured in parts by weight of the fuel additive. Similarly, in claims 96 and 97 the biocide is measured in parts by weight of the fuel additive. Claim 103 the metal deactivator is measured in parts by weight of the fuel additive. Accordingly, this rejection is not understood and not appropriate.

In paragraph 5 on page 5 of the Office Action, the Examiner rejected under 35 U.S.C § 132 the information presented in Paper Nos. 2 and 5 dated January 31, 2002 and October 22, 2002 respectively. The Examiner states that she did not find any amendment to page 1 of the instant specification. The amendment referred to by the Examiner is based on the addition on page 1 beginning at line 8 in line 12 after "microbial growth", the insertion of the word "strong" to "act as a demulsifier." As stated above, and as shown in the amendments to the specification in this response, the phrase "act as a strong demulsifier" has been deleted, and returned to the language of the original specification.

In paragraph 6 on page 5 of the Office Action, the Examiner stated that the amendment to page 9, at line 3 of paragraph 3, "changing "0.3 parts" to ---0.03 parts--- is considered new matter and contradict the limitation at @0.05 and at @0.15 of originally filed claim 38 and paragraph 3 in line 3 of page 9 in Paper No. 5 dated October 22, 2002." Applicants have amended the specification to go back to the original language.

In the first full paragraph on page 6 of the Office Action, the Examiner objects to the amendment to page 8 in line 3 of the third full paragraph of Paper No. 5 dated October 22, 2002 changing "0.03" to --0.05-- as new matter. The Examiner states that the applicant has not provided the basis for arbitrarily selecting the most preferably range as being the more preferably lower range. The Examiner noted that an example containing a single value was held not to be sufficient to support a claimed range containing said value, citing *In re Lukach*, 169 U.S.P.Q. 795 (CCPA 1971). The Examiner then concluded that a most preferable range would not be held sufficient to support a range containing said value. The applicant respectfully disagrees with both the Examiner's interpretation of *In re Lukach* and her subsequent conclusion.

As stated above, the ranges and then a narrower most preferred range describe a more preferred embodiment of the invention, and the correction was a correction of a typographical error, and therefore is not arbitrary. *In re Lukach* concerned a review of the rejection of all of the claims regarding ratios of a parent application, not a set of ranges from the application itself. The United States Court of Customs and Appeals was "unable to tell the relationship between the grandparent disclosure and the presently claimed

class of copolymers.” *In re Lukach*, 169 U.S.P.Q. 795, 798 (CCPA 1971). Therefore, the single ratio, not range, was insufficient to draw the connection for the court, and is not applicable to the instant case.

Further, *Ralston Purina Co. v. Far-Mar-Co.* applied *In re Lukach* and held that “the relevant inquiry is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” 772 F.2d1570, 1575 (Fed.Cir. 1985). This holding clearly shows that *In re Lukach*, is to be applied to parent and subsequent applications, and that the inventor must have possession of the claimed subject matter. The applicants are narrowing and describing their own invention and therefore demonstrates possession of the invention by describing these non-arbitrary ranges, and more preferable ranges. This demonstration through ranges and more preferable ranges and embodiments conveys to one skilled in the art that the applicant has possession.

In paragraph 2 on page 6 of the Office Action, the Examiner maintained the position that the deletion of lines 3-4 of paragraph 2 and the insertion at line 3 of paragraph 3 on page 3 of the instant application in Paper No. 2 dated January 31, 2002 constitute new matter. Both the deletion and the insertion of the above referenced matter have been canceled. The cancellation is shown in the amendments to the specification in this response (see replacement paragraphs for page 12, line 6 and page 12, line 11).

In paragraph 3 on page 6, the Examiner objected to the insertion at line 1 of Table 2 on page 13 as constituting new matter. The Examiner stated that because it was unclear from reading the instant specification if the Run values are based on percentage because the baseline percentage had not been established. The Examiner further stated that the RPM values for the fuel economy is not the same testing as the particulate emission testing because different testing were conducted. The amendment to the specification in this response shows the cancellation of the asterisks and related matter so that Table 2 now appears as it did in the originally filed application. Applicant submits that since the values in Table 1 are expressed as percentages, it would be expected and understood that values in Table 2 would also be so expressed. In addition, the specification of the originally filed application clearly states that the results listed in Tables 1 and 2 are the results of different tests performed on the same invention, simultaneously.

Table 1, on page 12 beginning at line 20, shows the percentage improvement of fuel economy based on stabilized RPMs which allowed for controlled testing of the fuel economy. The results shown in Table 2, on page 13 beginning at line 11, are from a qualitative smoke reduction test that was performed during the fuel economy testing. The exhaust was captured in filters and measured. The RPM was stabilized during this particulate test as it was done while the fuel economy test was performed. Again, the RPM stabilization was part of the experimental control to gather reliable results.

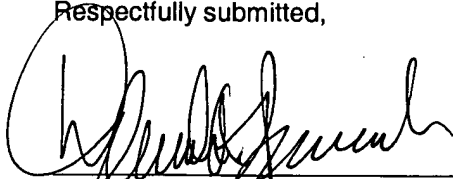
In the first full paragraph on page 7 of the Office Action, the Examiner rejected to the deletion of “462 patent” and insertion of the phrase “prior art” as the addition of new matter. The term “prior art” has been canceled and ‘462 added to go back to the original specification.

In paragraph 2 on page 7 of the Office Action, the Examiner states that the claims have not been treated on the merits over the prior art because the metes and bounds for the unit of measurement for the additives have not been established. As stated above, “parts by weight” and “parts by volume” are appropriate measurements, well known in the art. It is unbelievable that the Examiner would refuse to examine the application because “parts by weight” and “parts by volume” were used in a composition claim. Applicant has paid a filing fee for examination and has not been given the benefit of that examination.

In paragraph 3 on page 7 of the Office Action, the Examiner mentioned prior art as teaching “fuel additives comprising metallic-metallic compounds, stabilizers, solvents, lubricants, dispersants, metal deactivators and biocides of the same nature as claimed by the applicant.” However, the Examiner has not referred to any specific reference or combination of references or even what they say. Further, applicant does not have a “metallic-metallic” compound. Again, applicant requests an examination on the merits, without broad generalizations that the claims are rejected based on units of measurement and indeterminable prior art. Applicants and their attorney have spent numerous hours attempting to satisfy the Examiner’s concerns and amending the claims in light of the prior art. It is believed that all claims are allowable.

If any issues remain, or if the Examiner believes that prosecution of this application might be expedited by discussion of the issues, the Examiner is invited to telephone the undersigned attorney for Applicant at the telephone number listed below.

Respectfully submitted,

By: 
Deborah A. Peacock, Reg. No. 31,649
Direct line: (505) 998-1501

PEACOCK, MYERS & ADAMS, P.C.
Attorneys for Applicant(s)
P.O. Box 26927
Albuquerque, New Mexico 87125-6927

Telephone: (505) 998-1500
Facsimile: (505) 243-2542

Customer No. 005179

[G:\AMDS\ILFC\OAR Nov 6, 2003.doc]